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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,965	10/10/2000	Yuki Uchida	197849US-28	4230

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EXAMINER

DUONG, THOMAS

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,965

Applicant(s)

UCHIDA ET AL.

Examiner

Thomas Duong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51, and 53-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/2/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Amendment received November 16, 2004 has been entered into record. *Claims 1-51 and 53-76* remain pending.

Response to Amendment

3. This office action is in response to the applicants Amendment filed on November 16, 2004. Applicant amended *claims 1, 13, 25, 37, 42, and 47*, and added *claims 53-76*. *Claims 1-51 and 53-76* are presented for further consideration and examination.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-51 and 53-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delano (US006430558B1) and in view of Busey et al. (US006377944B1).

6. With regard to claims 1, 13, 25, 37, 42, and 47, Delano discloses,

- *providing said user with consulting advice regarding said request based upon data input by said user; (Delano; col.2, line 63 – col.3, line 39; col.5, line 55 – col.6, line 25)*

Delano teaches of a method for searching *“one or more knowledge databases formed by a combination of databases from a global network ... [including] steps of conducting search queries of content of at least one knowledge database, ranking content search results representative of the relative closeness of a requested search query to a search inputted by at least one user”* (Delano, col.3, lines 28-35). According to Delano, *“the collaborative search engine preferably also includes search content browsing means for browsing the content of the search results, search recommending means, e.g., a recommender, ... for recommending at least one of content providing (including content linking), alternative searching and alternative browsing queries to a user”* (Delano, col.5, lines 55-61) and presenting the user with the results.

- *selecting an application service provider based on said request; (Delano; col.2, line 63 – col.3, line 39; col.5, line 55 – col.6, line 25)*

Delano teaches of a method for searching *“one or more knowledge databases formed by a combination of databases from a global network ... [including] steps of conducting search queries of content of at least one knowledge database, ranking content search results representative of the relative closeness of a*

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requested search query to a search inputted by at least one user" (Delano, col.3, lines 28-35). Hence, one or more knowledge databases are used to obtain the user requested information.

- *forwarding said request to said application service provider; and* (Delano; col.2, line 63 – col.3, line 39; col.5, line 55 – col.6, line 25)

Delano teaches of a method for searching *"one or more knowledge databases formed by a combination of databases from a global network ... [including] steps of conducting search queries of content of at least one knowledge database, ranking content search results representative of the relative closeness of a requested search query to a search inputted by at least one user"* (Delano, col.3, lines 28-35). Hence, one or more knowledge databases are used to obtain the user requested information.

- *receiving information from said application service provider indicating information of a document provided from said application service provider to said user.*

(Delano; col.2, line 63 – col.3, line 39; col.5, line 55 – col.6, line 25)

Delano teaches that *"the collaborative search engine preferably also includes search content browsing means for browsing the content of the search results, search recommending means, e.g., a recommender, ... for recommending at least one of content providing (including content linking), alternative searching and alternative browsing queries to a user"* (Delano, col.5, lines 55-61) and presenting the user with the results.

However, Delano does not explicitly disclose,

- *receiving a request from a remote user;*

Busey teaches,

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- *receiving a request from a remote user; (Busey, col.4, lines 5-16; col.7, lines 19-45)*

Busey teaches of a *"method for providing information in response to a customer request for information ... using a communication network coupled to a database and coupled to a customer input/output device to convey information to and from the customer, the method includes the following steps: receiving signals from the input/output device to indicate a customer query to the database [and] returning information in response to the query"* (Busey, col.4, lines 5-13). According to Busey, *"the web-based nature of the WRU interface to the customer means that the WRU's processes can be executing at one or more remote computers"* (Busey, col.7, lines 35-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Busey with the teachings of Delano to further enhance the search engine of Delano by allowing remote accessibility and distributing processing to the search engine through the use of a web-based user interface.

7. With regard to claims 2, 4, 14, 16, 26, 28, 38, 43, and 48, Delano and Busey disclose,
 - *further comprising the step of providing said user with said document from said application service provider. (Delano; col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)*
8. With regard to claims 3, 15, 27, 39, 44, and 49, Delano and Busey disclose,

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- *further comprising the step of providing said application service provider with a user access level.* (Busey, col.6, line 62 – col.7, line 5; col.11, lines 8-20)
9. With regard to claims 5-7, 17-19, and 29-31, Delano and Busey disclose,
- *wherein the step of providing said documents to said user comprises:*
 - *delivering a print out of said document to said user; and*
 - *providing said user with a URL of said document.* (Delano; col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
10. With regard to claims 8, 20, and 32, Delano and Busey disclose,
- *further comprising the step of providing said application service provider with a user access level.* (Delano; col.2, line 63 – col.3, line 39; col.5, line 55 – col.6, line 25)
11. With regard to claims 11-12, 23-24, and 35-36, Delano and Busey disclose,
- *wherein the receiving information step comprises receiving the information which is the document.* (Delano; col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
 - *wherein the receiving information step comprises receiving the information which is a URL for said document.* (Delano; col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
12. With regard to claims 53-54, 57-58, 61-62, 65-66, 69-70, and 73-74, Delano and Busey disclose,

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- *wherein the consulting advice provided to said user includes document management advice.*
- *wherein the document management advice provided to said user includes advice on document search strategies, document retrieval costs, document storage strategies, document storage organization, updating of documents, protection of secured documents, or delivery options of documents. (Delano; col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)*

13. With regard to claims 53-54, 57-58, 61-62, 65-66, 69-70, and 73-74, Delano and Busey disclose,

- *wherein the data input by said user upon which the consulting advice is provided is obtained via a user interaction device by said user in response to a Series Of questions. (Delano; col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)*
- *wherein the data input by said user upon which the consulting advice is provided is generated based upon previously acquired data from said user. (Delano; col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)*

14. Claims 9-10, 21-22 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delano (US006430558B1), in view of Busey et al. (US006377944B1), and further in view of Kenner (US006112239A).

15. With regard to claims 9-10, 21-22 and 33-34, Delano and Busey disclose,

See claims 1, 13 and 25 rejection as detailed above.

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However, Delano and Busey do not explicitly disclose,

- *further comprising the steps of:*
 - *generating a unified bill from bills received from application service providers; and transmitting said unified bill to said user.*
- *wherein the receiving information step comprises receiving the information which is a billing information.*

Kenner teaches,

- *further comprising the steps of:*
 - *generating a unified bill from bills received from application service providers; and transmitting said unified bill to said user.* (Kenner, col.21, lines 16-28)

Kenner teaches of the use of a database to track the charges incurred by a user. According to Kenner, *"each user can have an associated 'account' to track charges, [and] the user can be charged for use of the Smart Mirror system by the file, by the megabyte, by the month, or by other means"* (Kenner, col.21, lines 20-23).

- *wherein the receiving information step comprises receiving the information which is a billing information.* (Kenner, col.21, lines 16-28)

Kenner teaches of the use of a database to track the charges incurred by a user. According to Kenner, *"each user can have an associated 'account' to track charges, [and] the user can be charged for use of the Smart Mirror system by the file, by the megabyte, by the month, or by other means"* (Kenner, col.21, lines 20-23).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Kenner with the teachings of

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Delano and Busey to further enhance the delivering controlled of formatted document for accounting purposes over a communications network, such as the internet, wherein information contained in the document is arranged into a pre-determined layout or file format upon request by the client.

Response to Arguments

16. Applicant's arguments with respect to *claims 1, 13, 25, 37, 42, and 47* have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is 571/272-3911. The examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571/272-6159. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9306 for After Final communications.

Thomas Duong (AU2145)

May 31, 2005


VALENCIA MARTIN-WALLACE
SUPERVISORY PATENT EXAMINER